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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,830	08/09/2006	Paul Shalk	DC10029 PCTI	4508

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DOW CORNING CORPORATION CO1232  
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EXAMINER
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TAYLOR, EARL N

ART UNIT	PAPER NUMBER
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2818

NOTIFICATION DATE	DELIVERY MODE
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06/27/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

## Office Action Summary

Application No.

10/588,830

Applicant(s)

SHALK ET AL.

Examiner

Earl N. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/9/2006</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

This office acknowledges receipt of the following items from the applicant:  
Information Disclosure Statement (IDS) filed on 9 August 2006. The references cited on the PTOL 1449 form have been considered.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Heeger et al. (International Publication WO 95/01871) as cited on applicant submitted IDS.**

Referring to Claim 1, Heeger teaches, in Fig. 10 (page 18, line 33 to page 20, line 25), an organic light-emitting diode comprising: a substrate (18) having a first opposing surface and a second opposing surface; a first electrode layer (12) overlying the first opposing surface; a light-emitting element (14) overlying the first electrode layer (12), the light-emitting element (14) comprising a hole-transport layer and an emissive/electron-transport layer, wherein the hole-transport layer and the

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emissive/electron-transport layer lie directly on one another, and the hole-transport layer comprises a cured polysiloxane (page. 12, lines 23-25) and a second electrode layer (16) overlying the light-emitting element. The language, term, or phrase "polysiloxane prepared by applying a silicone composition to form a film and curing the film, wherein the silicone composition comprises (A) a polysiloxane prepared by reacting a silane selected from at least one substituted silane having the formula  $R^1 SiX_3$  and a mixture comprising the substituted silane and at least one tetrafunctional silane having the formula  $SiX_4$  with water in the presence of an organic solvent, wherein  $R^1$  is  $-Y-Cz$ ,  $-(CH_2)_m-C_nF_{2n+1}$ , or  $-(CH_2)_m-C_6F_5$ , wherein  $Cz$  is N-carbazolyl,  $Y$  is a divalent organic group,  $m$  is an integer from 2 to 10,  $n$  is an integer from 1 to 3, and  $X$  is a hydrolysable group, and (B) an organic solvent", is directed towards the process of making a polysiloxane. It is well settled that "product by process" limitations in claims drawn to structure are directed to the product, *per se*, no matter how actually made. *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al.*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product *per se* which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or otherwise. The above case law further makes

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clear that applicant has the burden of showing that the method language necessarily produces a structural difference.

As such, the language “polysiloxane prepared by ...” only requires polysiloxane, which does not distinguish the invention from Heeger, who teaches the structure as claimed.

Referring to Claims 2-8, Heeger teaches all of the limitations of Claim 1. The entirety of Claims 2-8 are directed to the process of making the polysiloxane. It is well settled that “product by process” limitations in claims drawn to structure are directed to the product, *per se*, no matter how actually made. *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wethheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al.*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product *per se* which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or otherwise. The above case law further makes clear that applicant has the burden of showing that the method language necessarily produces a structural difference.

As such, the language “polysiloxane prepared by ...” only requires polysiloxane, which does not distinguish the invention from Heeger, who teaches the structure as claimed.

Referring to Claim 9, Heeger teaches all of the limitations of Claim 1 wherein the emissive/electron transport layer comprises a fluorescent dye (page. 3, Lines 21-29).

Referring to Claim 10, Heeger teaches all of the limitations of Claim 1 further comprising at least one of a hole-injection layer and an electron injection layer (page. 19, Line 7 to page. 20, Line 3).

***Telephone / Fax Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Earl N. Taylor whose telephone number is (571) 272-8894. The examiner can normally be reached on Monday-Friday from 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Loke can be reached on (571) 272-1657. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Earl N. Taylor

STEVEN LOKE  
SUPERVISORY PATENT EXAMINER

